

## REMARKS

The following remarks are provided in response to the Office Action dated October 30, 2003 in which the Examiner:

- rejected claims 1-2, 4-7, 9-10, 13, 25, 27-29, and 31-34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra et al. (hereinafter Misra) in view of Gradient, “Gradient Introduces End User Software License Creation and Delivery Tool for its iFOR/LS Licensing Technology,” dated March 21, 1994 (hereinafter Gradient), U.S. Patent No. 5,579,222 to Bains et al. (hereinafter Bains), and U.S. Patent No. 6,009,401 to Horstmann.

The applicants respectfully request reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections.

### **35 U.S.C. §103(a)**

The Examiner rejected claims 1-2, 4-7, 9-10, 13, 25, 27-29, and 31-34 under 35 U.S.C. §103(a) as being unpatentable over Misra in view of Gradient, Bains, and Horstmann. For at least the foregoing reasons the applicant traverses the Examiner’s rejection.

A *prima facie* case of obviousness under 35 U.S.C. §103 requires, among other criteria, that “. . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (See M.P.E.P. 706.02(j) and 2143.03). To overcome a §103(a) rejection, the applicants must only demonstrate that the cited prior art document or documents fail individually and in combination to teach or

suggest one element or limitation present in the claim.

The salient portion of currently amended independent claim 1 recites:

. . . generating, on a local computer, an install license for software installed on the local computer, wherein the install license is generated by the local computer in response to the software being installed. . .

Currently amended independent claim 13 is a machine-accessible medium claim and recites a similar limitation.

The Examiner notes that Misra discloses the generation of a first license on a license generator computer that is the same license generator that generates the second license; however, Misra **fails to explicitly disclose that a first computer generates a first license** (emphasis added). The Examiner instead relies on Horstmann to provide that the license certificate is stored on the end user's machine during installation. Specifically, Horstmann, column 3 lines 10-17 discloses ". . . a license certificate stored on the end user's machine during installation . . . ." Lines 59-64 indicate that ". . . and end user's machine has installed on it a license certificate and the relicensing manager . . . ." and that "[t]hese components will typically have been installed during original installation of a software product." The applicants respectfully disagree that the mere presence of a license certificate on the end user's machine equates to the end user's machine generating the license certificate. **Horstmann is directed to relicensing and does not disclose the local computer generating the install license.** The applicants respectfully assert that Misra in view of Horstmann fails to teach at least an element recited by currently amended independent claims 1 and 13.

The applicants maintain their position with respect to Gradient and Bains as discussed in previous Office Action responses. Accordingly, the applicants respectfully

affirm that currently amended independent claims 1 and 13 are patentable over Misra in view of Gradient, Bains, and Horstmann. As dependent claims 2, 4-7, 9-10, 25, 27-29, and 31-34 depend from nonobvious independent claims, the dependent claims are also nonobvious. (See M.P.E.P. §2143.03 (citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988))).

### CONCLUSION

For at least the foregoing reasons, the applicants submit that they have overcome the Examiner's rejections and that they have the right to claim the invention as set forth in the listed claims. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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Dated

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